



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/506,644

02/11/2005

Dorothee Hoischen

CS8336/LcA 35,861

4956

34469

7590

03/11/2008

BAYER CROPSCIENCE LP

Patent Department

2 T.W. ALEXANDER DRIVE

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

KLINKEL, KORTNEY L

ART UNIT

PAPER NUMBER

4131

MAIL DATE

DELIVERY MODE

03/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,644	Applicant(s) HOISCHEN ET AL.	
	Examiner Kortney Klinkel	Art Unit 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Election/Restrictions

Claims 18-50 are pending in the instant Office Action.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 18-21, 42 and 48 drawn to compounds and pesticides of formula (I) and a process of preparing pesticide comprising formula (I) respectively

Group II, claims 22-26, drawn to a process for preparing a compound of formula (I)

Group III, claim 27, drawn to a compound of formula (IX)

Group IV, claim 28, drawn to a process for preparing a compound of formula (IX)

Group V, claims 29-30, 43 and 49 drawn to compounds and pesticides of formula (II) and a process of preparing pesticide comprising formula (II) respectively

Group VI, claims 31-32, drawn to a process for preparing a compound of formula (II)

Group VII, claim 33, 44 and 50 drawn to a compound and pesticides of formula (VIII) and a process of preparing a pesticide comprising formula (VIII) respectively

Group VIII, claims 34-41, drawn to a process for preparing a compound of formula (VIII)

Group IX, claim 45, drawn to a method for controlling pests comprising...a compound of formula (I)

Group X, claims 46, drawn to a method for controlling pests comprising...a compound of formula (II)

Group XI, claim 47, drawn to a method for controlling pests comprising...a compound of formula (VIII)

The inventions listed as Groups I-XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature linking the claims is a substituted aryl ketone. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art.

In the present case, Van Almsick et al. (US 6376429) teach a large variety of substituted aryl ketones identical to those claimed by Applicant. As a result, no special technical features exist among the different groups because the inventions in Groups I-XI fail to make a contribution over the prior art. In conclusion, Groups I-XI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept, and therefore, restriction for examination purposes as indicated is proper.

Required Species Election if One of Groups I, II, or IX is Elected

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Substituted aryl ketones of formula (I)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. As an additional requirement, with the election of any of the above groups, a provisional election of species of a particular compound is also required. In order for this election to be considered fully responsive to this requirement the election must include:

- a) the compound name or structure,
- b) the location of the species within the claims or the specification,

c) the claims that read on the elected species, including any claims subsequently added

d) and a delineation of the exact substitutions on the general Markush formula,

e.g. R^1 is hydrogen, R^2 is halogen, X is cyano etc...

In the event that Group II is elected, Applicant is also requested to please select the appropriate structures of formula (II), (III), (IX), (XIII), (XI), (XIV), (V), (XV), and (VII) that correspond to the elected species of formula (I).

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 18-26, 42, 45 and 48.

Required Species Election if One of Either Groups III or IV is Elected

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Substituted aryl ketones of formula (IX)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. As an additional requirement, with the election of any of the above groups, a provisional election of species of a particular compound is also required. In order for this election to be considered fully responsive to this requirement the election must include:

a) the compound name or structure,

- b) the location of the species within the claims or the specification,
- c) the claims that read on the elected species, including any claims subsequently added
- d) and a delineation of the exact substitutions on the general Markush formula,
e.g. R^1 is hydrogen, R^2 is halogen, X is cyano, etc...

In the event that Group IV is elected, Applicant is also requested to please select the appropriate structures of formula (II) that correspond to the elected species of formula (IX).

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 27-28.

Required Species Election if One of Groups V, VI, or X is Elected

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Substituted aryl ketones of formula (II)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. As an additional requirement, with the election of any of the above groups, a provisional election of species of a particular compound is also required. In order for this election to be considered fully responsive to this requirement the election must include:

- a) the compound name or structure,

- b) the location of the species within the claims or the specification,
- c) the claims that read on the elected species, including any claims subsequently added
- d) and a delineation of the exact substitutions on the general Markush formula,

e.g. R^1 is hydrogen, R^2 is halogen, X is cyano etc...

In the event that Group VI is elected, Applicant is also requested to please select the appropriate structures of formula (VIII) and R^{12} that correspond to the elected species of formula (II).

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 29-32, 43, 46, and 49.

Required Species Election if One of Groups VII, VIII, or XI is Elected

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Substituted aryl ketones of formula (VIII)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. As an additional requirement, with the election of any of the above groups, a provisional election of species of a particular compound is also required. In order for this election to be considered fully responsive to this requirement the election must include:

- a) the compound name or structure,

- b) the location of the species within the claims or the specification,
- c) the claims that read on the elected species, including any claims subsequently added
- d) and a delineation of the exact substitutions on the general Markush formula,
e.g. R^1 is hydrogen, R^2 is halogen, X is cyano etc...

Applicant is also requested to please select the appropriate structures of formula (VI), (VII), (IV), (V), (X), (XI), (XII), R^{12} , and X^1 that correspond to the elected species of formula (VIII).

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 33-41, 44, 47 and 50.

Due to the complicated nature of the restriction, the restriction requirement is being made via written correspondence in lieu of a telephone interview.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres (571)272-0867 or Cecilia Tsang (571)272-0562 can be

Art Unit: 1625

reached at the respective numbers. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/JANET L ANDRES/

Supervisory Patent Examiner, Art Unit 4131